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Serial no. 09/883,621
Filed 6/18/2001
Attorney docket no. 10012116-1

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REMARKS

Note: Current office action is being treated as a final office action

In the Office Action Summary of the current Office Action, dated February 24, 2004, the Office Action is indicated as being non-final. However, on page 9 of this Office Action, and in the Interview conducted between Applicant's Attorney and the Examiner on February 2, 2004, as summarized in the Interview Summary prepared by the Examiner, the Office Action is indicated as a Final Office Action. Applicant presumes that the Office Action Summary is mistaken in identifying the current Office Action as being non-final, and therefore treats this Office Action as Final. Applicant requests that the Examiner contact Applicant's Attorney as soon as possible if this understanding of the current Office Action being a Final Office Action is incorrect.

Claims 1-2, 7, 10-13, 16, and 18: Section 103(a) Rejection

Claims 1-2, 7, 10-13, 16, and 18 have been rejected under 35 USC 103(a) as being unpatentable over Carroll (5,266,944) in view of Lyons (6,411,209) and Bursell (5,993,001). Applicant asserts that these claims are not rendered obvious over the cited prior art, and presents a number of separate and independent bases for their patentability. First, Lyons is not properly combined with Carroll, because there is no motivation to combine Lyons with Carroll. Second, Lyons is not properly combined with Carroll, because combining Lyons and Carroll renders Carroll inoperative for its stated purpose. Third, Bursell is not properly combined with Carroll in view of Lyons, because Bursell is non-analogous to Carroll, Lyons, and the claimed invention. Fourth, Bursell is not properly combined with Carroll in view of Lyons, because each claim has not been considered as a whole, and instead improper hindsight has been employed. Applicant now discusses in detail each of these separate and independent bases for patentability.

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First reason: No motivation to combine Lyons and Carroll

The Examiner has cited Carroll as teaching a camera and a detection mechanism to cause the camera to take one or more photos of a person, in response to detection of an event; Lyons as teaching a digital camera and a face detection and selection mechanism to determine the best photo of the one or more photos; and Bursell as teaching a database to store the best photo of the person with at least a current date in which the best photo was taken.

However, with specific respect to the Examiner's combining Lyons with Carroll so that the system of Carroll includes a face detection and selection mechanism, Applicant notes that section 2143.01 of the MPEP states that "the prior art must suggest the desirability of the claimed invention." More specifically,

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(*Id.*) There is no explicit or implicit motivation to combine Lyons with Carroll to include a face detection and selection mechanism.

In the context of a surveillance system like that of the claimed invention, the application as filed notes that at least some embodiments of the invention provide for certain advantages when used in the context of the premises of a store, thus representing the desirability of the claimed invention.

Rather than having to review several days worth of video tape from a video surveillance system, a user only has to scroll through the various faces stored in the database during a period of time, which is likely to be less time-consuming. . . . [T]he user may be able to search for the photo of the face of a desired person based on what has been purchased by him or her.

(P. 2, ll. 21-25, through p. 3, ll. 1-4) Having a face detection and selection mechanism thus is desirable in the claimed invention because it is likely to decrease the length of time for the user to review the photos of the faces of a number of persons that may have visited the premises of his or her store, in order to locate the photo of the face of a particular person (*e.g.*, to assist

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the authorities with finding the suspect in an attempted robbery, in case the suspect had previously cased the store during a previous, seemingly innocuous visit, and so on).

There is no comparable desirability in combining Lyons with Carroll to yield a system having a face detection and selection mechanism. Carroll is directed to

An electronic monitoring system that monitors an abuser for compliance with a protective order. When a violation is detected, the system automatically gathers evidence, independent of any that may be provided by the victim of the abuse, to establish probable cause of such violation.

(Abstract) The desirability of combining Lyons with Carroll to provide a face detection and selection mechanism is negligible at best. The electronic monitoring system of Carroll is meant to record a violation of an already known particular abuser of a protective order. There is no motivation to also include a face detection and selection mechanism by combining Lyons with Carroll so that, for instance, a particular face of a desired unknown person is easily found among the faces of a large number of unknown persons.

For example, in the case of a battered wife having sought a protective order against her estranged husband, there is no need to have a face detection and selection mechanism to identify the estranged husband and select the best photo of his face so that he can be easily recognized. The estranged husband would already be known – by the battered wife at least, and certainly by the fact that he has a uniquely identifiable transmitter bracelet attached to his leg, as shown in FIG. 2 of Carroll. In such cases, there will typically be only two faces in all the pictures of the husband and the wife, and the pictures will only be taken while the husband is violating the protective order. There is no motivation to combine Lyons with Carroll to include a face detection and selection mechanism, because the authorities do not have to comb through days worth of pictures to find pictures of the husband.

The Examiner states, by comparison, that Lyons is combinable with Carroll so that “the ‘best’ picture/image prior to storing the image for processing thereafter” can be “review[ed] and select[ed]” in order “to further provide convenience and time saving to the user/operator, and to preserve the memory space.” (Final Office Action, Page 3) Therefore, “such modification would have been an obvious expedient, well within the ordinary skill in the art, of providing Carroll with the latest technology of digital recording in lieu of a tape

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recording means.” (*Id.*) Applicant submits, however, that the Examiner is improperly considering whether the references *could* be combined, instead of that the references themselves suggest that they should not be combined.

As the MPEP and case law notes, “[t]he mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination.*” (*In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), *as cited in* MPEP sec. 2143.01) The Examiner’s reasoning that Lyons and Carroll are combinable since “such modification would have been an obvious expedient, well within the ordinary skill of the art” strikingly resembles the type of reasoning forbidden by *In re Mills*, which informs that although a prior art device “may be capable of being modified to run the way the apparatus is claimed, *there must be a suggestion or motivation in the reference to do so.*” (*Id.*) However, as has been discussed, the need, or motivation, for a face detection and selection mechanism in Carroll, which would be provided by combining Carroll with Lyons, is just not present in the references. That is, Carroll concerns itself with gathering evidence when there is a protective order violation, such as when an estranged husband enters the home of a battered wife.

The question is, therefore, whether there *actually* is a motivation to combine the face detection and selection mechanism of Lyons to the system of Carroll in such situations – and whether Lyons *could* be combined with Carroll. As has been noted, the reason why pictures are being taken in Carroll is because the estranged husband’s transmitter bracelet is detected as being in his wife’s home; there will not be multitudes of pictures to comb through to locate pictures of just the husband’s face, which the face detection and selection mechanism of Lyons would provide. As has also been noted, there will usually be just the faces of the husband and wife in the pictures taken in Carroll; pictures of their faces will thus easily be located without having to ever examine pictures of other people’s faces, which would be the reason for adding the face detection and selection mechanism of Lyons to Carroll.

Although the face detection and selection mechanism of Lyons could potentially be added to the surveillance system of Carroll, there is just no reason to take the trouble, time, and cost to do so, as it is simply not needed. That is, there is no explicit motivation in Carroll or Lyons to combine Carroll and Lyons. The Examiner’s recitation of convenience, time

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savings, etc., are generic motivations not found in the references, which themselves provide no suggestion for the desirability of adding a face detection and selection mechanism to Carroll.

Second reason: Combining Lyons with Carroll frustrates the intended purpose of Carroll

Combining Lyons with Carroll also frustrates the intended purpose of Carroll, render Carroll inoperative for its stated function. The crux of Carroll is to automatically gather evidence, via the camera, when the abuser of the protective order has tripped the detection mechanism. It is at least seemingly reasonable that the goal would be to gather as much evidence as possible. Introducing a face detection and selection mechanism, as combining Lyons with Carroll does, would mean that the large amount of evidence gathered would be culled down to a single photo of the face of the abuser, from which the abuser is most easily recognized. However, the point of having the evidence is not being able to easily identify the abuser per se, but rather to establish probable cause of the violation of a protective order.

Whittling down the pictures taken by the camera in Carroll to yield a single best photo of the face of the abuser would certainly not provide sufficient evidence of probable cause of the violation of the protective order by the abuser, although this is what combining Lyons with Carroll would require. Having only a single photo of the face of the abuser would more than likely provide *insufficient* evidence of probable cause, countering the entire point of having the electronic monitoring system of Carroll in the first place. Combining Lyons with Carroll thus destroys the intended functionality and purpose of Carroll.

Therefore, the Examiner's combination of Lyons and Carroll disregards the MPEP's instruction that "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." (MPEP sec. 2143.01) "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (*In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984), *cited in* MPEP sec. 2143.01) The purpose of Carroll is to record sufficient evidence so that probable cause of the violation of a protective order can be established. However, recording just a single photo of the face of the violator, as results from combining the face detection and selection mechanism of Lyons with the surveillance system of Carroll,

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would mean *reducing* the amount of evidence that is available to establish probable cause. Therefore, in accordance with the MPEP and *In re Gordon*, such a combination cannot be properly established.

The Examiner's reasoning that Lyons is combinable with Carroll to "provide convenience and time savings to the user/operator, and to preserve memory space" thus does not elevate the combination of Lyons and Carroll to proper *prime facie* obviousness. Although convenience, time savings, and reducing memory utilization are laudable goals, they conflict with the utmost purpose of Carroll, to secure sufficient evidence of probable cause. That is, the incentives given by the Examiner to combine Lyons and Carroll cannot act as a motivation to combine where combining Lyons and Carroll destroys the *explicit* intended functionality and purpose of Carroll. Saving time, and preserving memory space, do not matter in Carroll if the end result is that there is insufficient evidence of probable cause of violation of a protective order. Therefore, the Examiner's reasoning for combining Lyons with Carroll is decidedly unpersuasive.

In short, the Examiner must consider each prior art reference "in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." (*W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cited in* MPEP sec. 2141.02) The Examiner has failed to follow this instruction. Considering Carroll in its entirety means recognizing that it is desirable in Carroll to have the most video evidence possible so that sufficient evidence is available for proving probable cause. By comparison, adding the face detection and selection mechanism of Lyons to whittle the video evidence to just the best photo of the perpetrator does nothing to aid this effort, and indeed hinders acquiring sufficient evidence. Lyons is thus not properly combined with Carroll.

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Third Reason: Bursell is non-analogous to the claimed invention

As has been noted, the Examiner has cited Carroll as teaching a camera and a detection mechanism to cause the camera to take one or more photos of a person, in response to detection of an event; Lyons as teaching a digital camera and a face detection and selection mechanism to determine the best photo of the one or more photos; and Bursell as teaching a database to store the best photo of the person with at least a current date in which the best photo was taken.

It is dubious at best, however, that one of ordinary skill in the art would combine aspects of a stereoscopic imaging system for retinal examination, to which Bursell is directed, with the electronic monitoring system of Carroll and the security monitoring system of Lyons. Applicant notes that the claimed invention is directed to surveillance systems. As such, Bursell is non-analogous prior art to the claimed invention, and therefore is not combinable with Carroll in view of Lyons. Absent a clear motivation within the prior art to combine electronic monitoring systems with stereoscopic imaging systems for retinal examinations, Bursell cannot be combined with Carroll and Lyons.

Bursell is specifically directed to a stereoscopic imaging system for retinal examination. This is highly non-analogous to a surveillance system.

The Federal Circuit has noted that

[a] reference is reasonably pertinent if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem . . . [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

In re Clay, 966 F.2d 656 (Fed. Cir. 1992) The Federal has also stated that

We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances" – in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992) Applicant asserts that one of ordinary skill within the art would not look to Bursell in addressing the problem that the claimed invention

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solves, nor is it common sense to look to Bursell in addressing the problem that the claimed invention solves.

The filed patent application describes the type of problems that are solved by the claimed invention.

[S]uch surveillance systems have some disadvantages. For example, if a theft has occurred, but the exact time of which is not known, several days worth of videotape may have to be reviewed to learn who has perpetrated the theft. This can be a very time-consuming and inconvenient process.

(P. 1, ll. 19-22) The invention of claim 1 solves these and other problems, as also recited in the filed patent application.

Rather than having to review several days worth of videotape from a video surveillance system, a user only has to scroll through the various faces stored in the database during a period of time, which is likely to be less time-consuming.

(P. 2, ll. 22-25)

By comparison, Bursell is directed to subject matter that is wholly unrelated – and non-analogous – as compared to the surveillance systems and methods of the claimed invention. Bursell is directed to a stereoscopic imaging system for retinal examination. The recited field of the invention of Bursell is that it “relates to systems and methods for examining and treating the eye, and more particularly, to . . . systems . . . that provide stereoscopic images of the retina of an eye.” (Col. 1, ll. 10-15) The background section in Bursell is also informative.

Diabetes is the leading cause of blindness in working age adults. It is disease that, among its many symptoms, includes a progressive impairment of the peripheral vascular system. These changes in the vasculature of the retina cause progressive vision impairment and eventually complete loss of sight.

Accordingly, it would be desirable to implement more widespread screening for retinal degeneration or pathology, and to positively address the financial, social and cultural barriers to implementation of such screening. It would also be desirable to improve the efficiency and quality of retinal evaluation.

(Col. 1, ll. 15-22; col. 2, ll. 1-6)

Bursell is thus non-analogous to the surveillance systems and methods of the claimed invention. The surveillance systems and methods of the claimed invention have nothing to do

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with retinal examination. The surveillance systems and methods of the claimed invention have nothing to do with diabetes, or the peripheral vascular system. The surveillance systems and methods of the claimed invention have nothing to do with implementing eye screening, nor with improving the quality of retinal evaluations. As such, Bursell is improperly relied upon as analogous prior art to the claimed invention, and is not properly combined with Carroll in view of Lyons.

The Examiner's stated motivation for combining Bursell with Carroll in view of Lyons is that doing so would "provide date identification to the photo to further keep track of the photos with [the] date taken on it." Again, although this is a laudable goal, it does not lessen the non-analogous nature of Bursell to the surveillance system of claim 1, the electronic monitoring system of Carroll, and the security monitoring system of Lyons. Non-analogous art cannot be combined with analogous art to yield the subject matter of an invention.

That is, regardless of whether the Examiner's motivation for combining Bursell with Carroll and Lyons is correct or proper, the crux of the matter is that the Examiner should not have even looked to Bursell in the first place. "The rationale behind this rule precluding rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art." (*In re Wood*, 599 F.2d 1032 (CCPA 1979)) "In order to rely on a reference as a basis for rejection of an application's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." (*In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992), *cited by* MPEP sec. 2141.01(a)) At the end of the day, it is highly unlikely that one of ordinary skill within the art of surveillance systems for security purposes would look to or be aware of prior art references within the art of retinal examination systems used for medical purposes.

Fourth Reason: Claims each not considered as a whole, rather improper hindsight employed

Applicant's final reason why Bursell, Carroll, and Lyons are not properly combinable to yield the claimed invention is a holistic one. As guided by the MPEP, "[i]n determining the differences between the prior art and the claims, the question under 35 USC 103 is not

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whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious.” (*Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983), *cited in* MPEP sec. 2141.02). As stated by the Federal Circuit,

It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

(*In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992), *quoting In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988))

Established patent law scholars have also recognized the siren call to engage in impermissible hindsight reconstruction of the claimed invention, in contradistinction to examining the claimed invention as a whole.

Often, an Examiner may get caught up in the examination process and focus too much on rejection an application as obvious over the prior art. In these circumstances, he or she might forget to examine the claim *as a whole*.

For example, one sign of a potentially defective obviousness rejection is the inclusion of separate references to represent each of the different features described in the claims of the application. In this situation, the Examiner attempts to piece together the claimed invention using the claims as a guide. . . . Thus, the Examiner, in effect, uses the claims of the patent as an instruction manual to find the appropriate prior art that might render the claims obvious.

Thus it is not correct for the Examiner merely to focus on the differences between the prior art and the claimed invention, and then to state that the differences themselves or individually are obvious. The claimed invention as a whole must be considered.

(Irah H. Donner, *Patent Prosecution: Practice & Procedure Before the US Patent Office*, 3rd ed., pages 828-829 (2003))

Against this backdrop of established case law, MPEP regulation, and scholarly insight, Applicant postulates that the Examiner has failed to consider the claimed invention as a whole, and instead has engaged in the type of impermissible hindsight admonished above, using the claimed invention as an instruction manual or template to piece together the teachings of the

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prior art to yield the invention. Claim 1 is typical in this regard. Claim 1 is directed to a surveillance system having four parts: a digital camera; a detection mechanism; a face detection and selection mechanism; and, a database. Yet to render the invention of claim 1 obvious, the Examiner has had to resort to no less than three references: Carroll to find the digital camera and detection mechanism; Lyons to next find the face detection and selection mechanism; and Bursell to finally find the database. As has already been discussed, Bursell comes from a very disparate field of technology than does Lyons and Carroll, and Lyons and Carroll are themselves not properly combined. The question here, however, is, could the Examiner have come up with the claimed invention except by using improper hindsight and the invention as a template by which to search for prior art? The answer is no.

Each of the Examiner's combinations – Lyons with Carroll, and Bursell with Lyons and Carroll – is individually weak. For example, the Examiner's motivation for combining Lyons and Carroll relies on generic "convenience" arguments that ignore the explicit teachings of Carroll. As another example, the Examiner's combining Bursell with Lyons and Carroll takes the non-analogous retinal technology of Bursell and tries to piece it together with the monitoring systems of Lyons and Carroll. However weak the Examiner's combinations are individually, together they are even weaker. The Examiner finds the first two elements of claim 1, for instance, in one reference, Carroll; the third element of claim 1 in another reference, Lyons; and, the fourth element of claim 1 in yet another reference, Bursell. Each time the Examiner adds a reference, a vague motivation to combine is cited, providing an incremental reason why adding the next reference to the previous reference or references is obvious. Yet the Examiner never considers "the obviousness of *the claimed invention as a whole*," as required by the MPEP and case law. That is, "the actual determination of the issue requires an evaluation . . . of the obviousness of *the claimed invention as a whole*, not merely the *differences* between the claimed invention and the prior art." (*Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881 (Fed. Cir. 1984))

Such evaluation is never accomplished by the Examiner. The Examiner whips up an interesting recipe, adding a prior art reference here, a prior art reference there, and after enough references have been added, *voila*, the claimed invention results. However, the

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intrinsic weakness in the Examiner's cooking is that without using the claimed invention as the recipe, it is difficult to surmise that one of ordinary skill within the art would first combine Lyons with Carroll, especially where Carroll's purpose is frustrated by such combination, and then would combine Bursell to Lyons and Carroll, especially where Bursell comes from such a highly non-analogous art area. Applicant submits that it strains common sense to combine Carroll, Lyons, and Bursell as the Examiner has done without engaging in impermissible hindsight. The facts surrounding this issue – the first two elements of claim 1, for instance, being found in the first reference; the third element of claim 1 being found in the second reference; and the last element of claim 1 being found in the third reference, as if the Examiner were neatly following the claimed invention in guiding her reconstruction of the prior art – buttress this conclusion as well.

The Examiner counters that

[I]t must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

(Final Office Action, page 8, *citing In re McLaughlin*, 443 F.2d 1392 (CCPA 1971)) *In re McLaughlin* is undoubtedly correct, but its recitation by the Examiner cannot be used as a panacea to cure all the defects of the Examiner's reasoning process. The fact of the matter is that the Examiner utilizes nearly as many references as there are elements in claim 1, that the Examiner's stated motivations for combining the references are weak, generic, or fly in the face of MPEP instruction, and that the Examiner's reconstruction of the invention neatly follows the ordering of the elements in claim 1, all point otherwise – that the Examiner has engaged in impermissible hindsight, using the claimed invention as a template in locating prior art, without ever considering the claimed invention as a whole.

Claims 3 and 19: Section 103(a) Rejection

Claims 3 and 19 have been rejected under 35 USC 103(a) as being unpatentable over Carroll in view of Lyons and Bursell, and further in view of Lee (5,151,945). Claim 3 is a

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dependent claim depending ultimately from independent claim 1. Therefore, claim 3 is patentable for at least the same reasons that claim 1 is patentable. Claim 19 is a dependent claim ultimately depending from independent claim 18. Therefore, claim 19 is patentable for at least the same reasons that claim 18 is patentable.

Claims 4-5 and 14-15: Section 103(a) Rejection

Claims 4-5 and 14-15 have been rejected under 35 USC 103(a) as being unpatentable over Carroll in view of Lyons and Bursell, and further in view of Clever (4,145,715). Claims 4-5 are dependent claims ultimately depending from independent claim 1, and therefore are patentable for at least the same reasons that claim 1 is. Claims 14-15 are dependent claims ultimately depending from independent claim 11, and therefore are patentable for at least the same reasons that claim 11 is.

Furthermore, Applicant asserts that claims 4-5 and 14-15 are specifically independently patentable, irrespective of the patentability of claims 1 and 11 from which they depend. Claim 4 recites the detection mechanism being a cash register, such that ringing up a sale to the person on the cash register causes the digital camera to take one or more photos of the person. Claim 14 recites detecting a sale to the person having been rung up on a cash register as the event in response to which one or more photos of the person are taken. Claim 5 depends from claim 4, and claim 15 depends from claim 14. Therefore, claims 5 and 15 are patentable for at least the same reasons that claims 4 and 14 are patentable.

Applicant submits that Carroll in view of Lyons and Bursell, and further in view of Clever, do not disclose the invention of claims 4 and 14. The Examiner has stated that

Clever teaches a surveillance system, having a camera used in conjunction with a cash register 14 at a point of sale transaction, where the functionality of the cash register is to ring up a sale to a person on the cash register for a transaction purpose.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to apply the detection mechanism of Carroll as modified by Lyons and Bursell to the point of sale transaction system as taught by Clever in order to obtain a clear image identification detection system in sale environment for the purpose of capturing the customer's identification and image record keeping Accordingly, it would have been an obvious

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modification as taught by Carroll as modified by Lyons and Bursell in applying a known system to other operations.

(Final Office Action, p. 5)

However, the Examiner has neglected to consider all the words in claims 4 and 14 in judging their patentability. "Distilling an invention down to the 'gist' or thrust' of an invention disregards the requirement of analyzing the subject matter 'as a whole.'" (MPEP sec. 2141.02, citing *W.L. Gores & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)) "The subject matter of a properly construed claim is defined by the terms that limit its scope. *It is this subject matter that must be examined.*" (MPEP sec. 2106) Claims 4 and 14 are directed to the ringing up of a sale to a person on the cash register as causing the digital camera to take one or more photos of the person. The cash register is itself the detection mechanism. By comparison, Clever, while disclosing a cash register within a point of sale transaction environment, does not disclose the use of a sale itself on the cash register as causing pictures to be taken.

The Examiner has thus seemingly missed the point of claims 4 and 14 by failing to consider all their words. It is beside the point whether the detection mechanism of Carroll, as modified by Lyons and Bursell, is applicable to the point of sale transaction system as taught by Clever. The point of difference is that the detection mechanism of Carroll, as modified by Brennan and Bursell, does not disclose using a cash register – and the ringing up of a sale thereon – as the detection mechanism to cause photos of a person to be taken, nor does Clever teach such usage of a cash register and the ringing up of a sale thereon. Clever, and Carroll in view of Lyons and Bursell and further in view of Clever, do not render the invention of claims 4 and 14 obvious.

Applicant notes that the reasoning provided by the Examiner with respect to claims 4 and 14 in the Final Office Action is nearly identical to the reasoning provided in the two earlier, non-final office actions. While the Examiner acknowledged the receipt of the earlier response, the Examiner has not particularly discussed this reasoning as to claims 4 and 14. The Examiner merely recited, nearly word for word, the same reasoning as provided in the first office action. Yet Applicant refuted this reasoning, as substantially duplicated above,

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without further comment by the Examiner. Merely resubmitting the previous arguments from an earlier office action in a new office action, however, is not proper, without some indication as to why the Examiner did not find Applicant's refutation of this reasoning improper – and the Examiner provided no comment on Applicant's reasoning.

Claim 6: Section 103(a) Rejection

Claim 6 has been rejected under 35 USC 103(a) as being unpatentable over Carroll in view of Lyons and Bursell, and further in view of Monroe (6,366,311). Claim 6 is a dependent claim depending ultimately from independent claim 1. Therefore, claim 6 is patentable for at least the same reasons that claim 1 is patentable.

Claims 8-9, 17, and 20: Section 103(a) Rejection

Claims 8-9, 17, and 20 have been rejected under 35 USC 103(a) as being unpatentable over Carroll in view of Lyons and Bursell, and further in view of Kuperstein (6,128,398). Claims 8-9 are dependent claims ultimately depending from independent claim 1, and therefore are patentable for at least the same reasons that claim 1 is patentable. Claims 17 and 20 are dependent claims ultimately depending from independent claims 11 and 18, and therefore are patentable for at least the same reasons that claims 11 and 18 are patentable.

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Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



April 21, 2004
Date

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